

Notice of Allowability

Application No.

10/695,892

Examiner

George Suchfield

Applicant(s)

CHATTERJI ET AL.

Art Unit

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 4/8/04 Amendment.
2. ☒ The allowed claim(s) is/are 37-55,77 and 79-91.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 12/15/03; 3/19/04; 3/29/05
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 9/1/05
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

George Suchfield
Primary Examiner
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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-36, 56, 59-62 and 64-76, drawn to a composition, classified in class 106, subclass .
 - II. Claims 37-55, 77 and 79-91, drawn to a method of cementing a well, classified in class 166, subclass 293.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the composition or product could be used in cementing applications other than the Group II invention, e.g., as a cement for building, highway or dam construction.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
5. During a telephone conversation with Craig W. Roddy on August 31, 2005 a provisional election was made without traverse to prosecute the invention of Group II, claims 37-55, 77 and 79-91. Affirmation of this election must be made by applicant in replying to this Office action.

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Claims 1-36, 56, 59-62 and 64-76 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. The following is an examiner's statement of reasons for allowance:

The primary reason for the allowance of claims is that none of the references cited, taken either singly or in combination, teach or disclose a method of cementing a subterranean zone, as in the claimed combinations, including the representative step (a) of claim 37, i.e., wherein the hydraulic cementing slurry prepared and placed in the subterranean zone includes an oil suspension of silica powder, mineral oil, an oleophilic clay, and both a olephilic surfactant and a hydrophilic surfactant. For example, Brooks, Jr. (3,131,075) discloses a method of cementing a subterranean zone or well wherein the cementing slurry is prepared by the addition of an oil containing an emulsifying agent, rather than an oil suspension, to an aqueous cementing slurry to form an oil-in-water emulsion, to which a silica powder or component is subsequently added. Such oil phase or component further does not contain an oleophilic clay or mixture of a hydrophilic and oleophilic surfactants.

8. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

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fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

9. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Craig Roddy on September 1, 2005, whereupon it was agreed to make the changes set forth below. In this regard, in claim 48, of will be changed to "at" since viscosity is not measured by degrees; claim 77 will be amended to recite proper Markush language, as per MPEP Section 2173.05(h).

The application has been amended as follows:

Claims 1-36, 56, 59-62 and 64-76 to the non-elected invention have been cancelled.

In claim 48, line 2, the recitation "viscosity of" has been changed to -- viscosity at --.

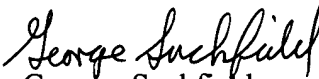
In claim 77, lines 3 and 4, the recitation "which comprises" has been changed to -- selected from the group consisting of --; in line 5 of claim 77, "or" has been changed to -- and --

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Suchfield whose telephone number is 571-272-7036. The examiner can normally be reached on M-F (6:30 - 3:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


George Suchfield
Primary Examiner
Art Unit 3676

Gs
September 1, 2005